

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

App. No. : 10/821,969
Applicant : Marieke Iwema, *et al.*
Filed : April 12, 2004
Group Art Unit: 2173
Examiner : Not yet assigned

Confirmation No. 3099

Docket No. : MFCP.110967
Customer No. : 45809

Box Missing Parts
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NON-SIGNING INVENTOR (37 C.F.R. § 1.47(a))

Dear Sir:

This statement is made to the exact facts that are relied upon to establish the diligent effort made to secure the execution of the declaration by the non-signing inventor of the above-identified patent application.

I. The Inventors of the claims of the application are identified on the enclosed declaration and include: Marieke Iwema Watson, Kelly E. Rollin, Oliver C. Lee, Stephen P Proteau, Colin R. Anthony, and Robert M. Girling.

II. All of the inventors have signed the declaration with the exception of Robert M. Girling.

III. The last known address of Robert M. Girling is:

9647 Observation Drive
Kirkland, WA 98033
US Citizen

IV. After diligent efforts, I have been unable to obtain the signature of Mr. Girling on the declaration and Mr. Girling has refused to sign the declaration as evidenced by the facts below.

A. On March 23, 2004 and April 5, 2004, we attempted to contact Mr. Girling through his employer, the Microsoft Corporation. On April 5, 2004, we learned that his employment had terminated and received his last known address. See Exhibit A.

B. On April 7, 2004, we sent the patent specification and patent drawings to Mr. Girling, along with a declaration and assignment for his signature. We requested that he return signed copies of the assignment and declaration by April 12, 2004. See Exhibit B.

C. On Monday, August 2, Robert Girling contacted co-inventor Marieke Watson after receiving her email, also dated August 2, to inform her that he was "not really interested" in being on the patent. See Exhibit C.


D. On Friday, August 20, I contacted Robert Girling by email to advise him that we are required to obtain signatures from all inventors. See Exhibit D. Mr. Girling did not respond to this email.

E. On September 17, 2004, we forwarded a copy of the application as filed, assignment, and declaration to Mr. Girling via Express Mail, again explaining the documents and requesting his signature. See Exhibit E.

F. On Thursday, September 23, I received an email from Mr. Girling informing us that he is unwilling to sign the assignment and declaration documents. See Exhibit F.

Respectfully submitted,

Date: October 25, 2004


Kerry H. Owens
Registration No. 37,412

SHOOK, HARDY & BACON L.L.P.
2555 Grand Blvd.
Kansas City, Missouri 64108-2613
Telephone (816) 474-6550
Facsimile (816) 421-5547

Cruz-Boyden, Romana "Lynn" (SHB)



From: David Stone (LCA) [dstone@microsoft.com]
Sent: Monday, April 05, 2004 1:28 PM
To: Cruz-Boyden, Romana "Lynn" (SHB)
Subject: RE: MS#302800.01 (Our Reference:

I don't show him as an employee any longer. But here is his info.
Robert M. Girling - U.S. citizen
9647 Observation Drive
Kirkland, WA. 98033

Thanks, David

From: Cruz-Boyden, Romana "Lynn" (SHB) [mailto:RBOYDEN@shb.com]
Sent: Monday, April 05, 2004 10:11 AM
To: David Stone (LCA)
Subject: MS#302800.01 (Our Reference: MFCP.110967)

David,

Robert Girling is listed as an inventor on the invention disclosure that we received for MS#302800.01. I am unable to find his name listed on the Inventor Address List located on the Patent Group Outside Counsel website. Does he still work for Microsoft? Is there another way to find out his address and country of citizenship for the formal documents?

Thank you in advance for your help.

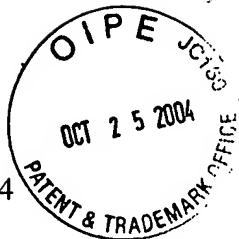
Lynn Cruz-Boyden
Intellectual Property Legal Secretary

"MMS <shb.com>" made the following
annotations on 04/05/2004 12:11:24 PM

CONFIDENTIALITY NOTICE: This e-mail message including attachments, if any, is intended for the person or entity to which it is addressed and may contain confidential and/or privileged material. Any unauthorized review, use, disclosure or distribution is prohibited. If you are not the intended recipient, please contact the sender by reply e-mail and destroy all copies of the original message. Thank you.

4/5/2004

April 7, 2004



Shook,
Hardy &
Bacon, L.L.P.
www.shb.com

Kerry H. Owens

VIA FEDERAL EXPRESS

Mr. Robert M. Girling
9647 Observation Drive
Kirkland, WA 98033

Hamilton Square
600 14th Street, N.W., Suite 800
Washington
D.C. 20005-2004
202.783.8400
202.783.4211 Fax
kowens@shb.com

Re: New U.S. Patent Application
Title: SYSTEM AND METHOD FOR
PROVIDING AN INTERACTIVE DISPLAY
Microsoft Reference No.: MS#302800.01
Our Reference No.: MFCP.110967

Dear Mr. Girling:

The four enclosures include a revised patent application, patent drawings, a declaration, and an assignment. The patent application has been revised in accordance with the comments provided by Steve Proteau.

By signing the attached declaration, you will be swearing that you are an inventor of the claimed subject matter and you will be enabling us to prosecute this patent application in the USPTO on your behalf. By signing the attached assignment, you will be assigning your rights in the application to Microsoft.

Please review the application to verify that you are an inventor and review the assignment and declaration documents to verify your address and citizenship information. We will be filing this application on **Monday, April 12, 2004**. Accordingly, please sign the assignment and declaration documents next to your name and fax them back to us at 202-783-4211. You may also scan the documents and email them or return them in the enclosed postage-paid envelope if you prefer.

Thank you for your cooperation. If you have questions, please contact Lynn CruzBoyden or me at 202-783-8400 or by email.

Very truly yours,

Kerry H. Owens

KHO:lcb
Enclosures

Geneva
Houston
Kansas City
London
Miami
New Orleans
Orange County
Overland Park
San Francisco
Tampa
Washington, D.C.

Cruz-Boyden, Romana "Lynn" (SHB)

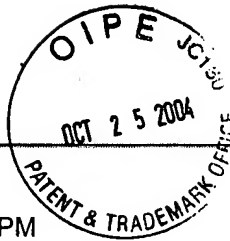
From: Robert Girling [robtgir@hotmail.com]
Sent: Monday, August 02, 2004 5:32 PM
To: Marieke Watson (IWEMA); Cruz-Boyden, Romana "Lynn" (SHB)
Subject: Re: patent for carousel

Hey Marieke,
Hope all is well with you too, and the Longhorn project isn't getting too long.
I'm not really interested in being on the patent for the Carousel. I guess they should just file without me.
Cheers.
Rob.

----- Original Message -----

From: Marieke Watson (IWEMA)
To: Robtgir@hotmail.com
Sent: Monday, August 02, 2004 11:01 AM
Subject: patent for carousel

Hey Rob, hope all is well.
Somebody from legal is trying to contact you for the patent disclosure for the Carousel.
Would you mind contacting her to get the documents that need to be signed?
You can reach her at:
Thanks,
marieke



Owens, Kerry H. (SHB)

From: Owens, Kerry H. (SHB)
Sent: Friday, August 20, 2004 3:14 PM
To: 'robtgir@hotmail.com'
Subject: MS 302800.01/MFCP.110967

Rob,

I am the outside counsel who filed the patent application for the Carousel concept. I hate to bother you with patent details and I understand that you are no longer with Microsoft. Unfortunately, to fulfill legal obligations, this communication is necessary.

We filed the application several months ago. All of the other inventors have signed a declaration and assignment that have your name on it.

Unfortunately, we can't take your name off the patent unless you are telling us that you were not an inventor. Inventorship is determined by the claims of the application. Please review the claims of the attached application (pages 19-22). If you are not an inventor, please let us know so that we can take appropriate steps.

Alternatively, if you determine that you are an inventor, please sign and return the documents via facsimile (202-783-4211) or by scanning signed copies in and emailing them. We would also be happy to send a postage paid envelope if you prefer.

If we don't hear from you either way (that you are an inventor or that you are not), then it is likely that you will receive some further communications from Microsoft.

Thanks very much for your time and sorry for the inconvenience.
 Kerry

[Owens, Kerry H. (SHB)] -----Original Message-----

From: Robert Girling [mailto:robtgir@hotmail.com]
Sent: Monday, August 02, 2004 5:32 PM
To: Marieke Watson (IWEMA); Cruz-Boyden, Romana "Lynn" (SHB)
Subject: Re: patent for carousel

Hey Marieke,

Hope all is well with you too, and the Longhorn project isn't getting too long.

I'm not really interested in being on the patent for the Carousel. I guess they should just file without me.

Cheers.

Rob.

----- Original Message -----

From: Marieke Watson (IWEMA)
To: Robtgir@hotmail.com
Sent: Monday, August 02, 2004 11:01 AM
Subject: patent for carousel

Hey Rob, hope all is well.

Somebody from legal is trying to contact you for the patent disclosure for the Carousel.

Would you mind contacting her to get the documents that need to be signed?

You can reach her at:

9/16/2004

Thanks,
marieke

9/16/2004

September 17, 2004



Kerry H. Owens

VIA EXPRESS MAIL

Mr. Robert Girling
9647 Observation Drive
Kirkland, Washington 98033

Hamilton Square
600 14th Street, N.W., Suite 800
Washington
D.C. 20005-2004
202.783.8400
(202) 639-5647 DD
202.783.4211 Fax
kowens@shb.com

Re: Utility Patent Application No. 10/821,969
Title: SYSTEM AND METHOD FOR
PROVIDING AN INTERACTIVE DISPLAY
Filed: April 12, 2004
Microsoft No.: 302800.01
Our Ref.: MFCP.110967

Dear Rob:

Attached is a copy of the above-referenced patent application that was filed several months ago. Assignment and Declaration documents are also enclosed. Please sign and return the documents via facsimile (202-783-4211). You may also scan the signed documents and email them or return them in the enclosed postage paid envelope.

By signing the attached declaration, you will be swearing that you are an inventor of the claimed subject matter and you will be enabling us to prosecute this patent application in the USPTO on your behalf. By signing the attached Assignment, you will be assigning your rights in the application to Microsoft.

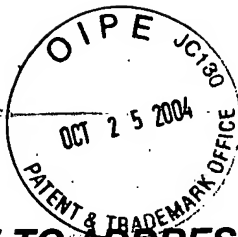
If you do not intend to sign the documents, please communicate this to us, so that we can take appropriate action in the USPTO. We will contact you repeatedly until we either receive the signed documents or a statement from you that you have no intention on signing the documents. Thank you for your cooperation and we look forward to hearing from you.

Very truly yours,

Kerry H. Owens

KHO:lcb
Enclosures

Geneva
Houston
Kansas City
London
Miami
New Orleans
Orange County
Overland Park
San Francisco
Tampa
Washington, D.C.



POST OFFICE TO ADDRESSEE

SEE REVERSE SIDE FOR
SERVICE GUARANTEE AND
INSURANCE COVERAGE LIMITS

ORIGIN (POSTAL USE ONLY)

PO ZIP Code <u>20213</u>	Day of Delivery <input type="checkbox"/> Next <input checked="" type="checkbox"/> Second	Flat Rate Envelope <input type="checkbox"/>
Date In Mo. <u>9</u> Day <u>17</u> Year <u>04</u>	<input type="checkbox"/> 12 Noon <input checked="" type="checkbox"/> 4 PM	Postage \$ <u>13.65</u>
Time In <input type="checkbox"/> AM <input checked="" type="checkbox"/> PM	Military <input type="checkbox"/> 2nd Day <input type="checkbox"/> 3rd Day	Return Receipt Fee
Weight lbs. <u>0.76</u>	Int'l Alpha Country Code	COD Fee
No Delivery <input checked="" type="checkbox"/> Weekend <input type="checkbox"/> Holiday	Acceptance Clerk Initials <u>[Signature]</u>	Insurance Fee
		Total Postage & Fees \$ <u>13.65</u>

☐ **WAIVER OF SIGNATURE (Domestic Only)** Additional merchandise insurance is void if waiver of signature is requested. I wish delivery to be made without obtaining signature of addressee or addressee's agent (if delivery employee judges that article can be left in secure location) and I authorize that delivery employee's signature constitutes valid proof of delivery.

NO DELIVERY ☐ Weekend ☐ Holiday

Customer Signature: _____

CUSTOMER USE ONLY

METHOD OF PAYMENT

Express Mail Corporate Acct. No.

FROM: (PLEASE PRINT)

PHONE

202.788.8820

Kerry H. Owens
Shook Hardy & Bacon LLP
600 14th Street, NW #800
Washington, DC 20005-2004

Federal Agency Acct. No. or
Postal Service Acct. No.

TO: (PLEASE PRINT)

PHONE ()

Robert Girling
9647 Observation Drive
Kirkland, WA

ZIP +4

98033 +

FOR PICKUP OR TRACKING CALL 1-800-222-1811

www.usps.com



Customer Copy